UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,631	04/06/2001	Joseph James Valorose III	D5009-00018	5521

8933 7590 02/01/2005

DUANE MORRIS, LLP
IP DEPARTMENT
ONE LIBERTY PLACE
PHILADELPHIA, PA 19103-7396

EXAMINER	
RIES, LAURIE ANNE	
ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/828,631	VALOROSE, JOSEPH JAMES	
	Examiner	Art Unit	
	Laurie Ries	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to communications: amendment, filed 11/4/2004, to the original application, filed 4/6/2001.

Claim 18 remains rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The "carrier wave" cited in claim 18 can be defined as a physical thing as stated by Applicant, however, it is not considered tangible as defined under 35 U.S.C. 101. A carrier wave is not a "machine, manufacture or composition" and therefore is not tangibly embodied as implemented in claim 18 of the instant application.

Claims 1-20 are pending. Claims 1, 15, 16, 17, 18, and 19 are independent claims.

Response to Arguments

Applicant's arguments, see amendment, filed 11/4/2004, with respect to the rejection(s)of claim(s) 19-20 under 35 U.S.C. 102(e) and claim(s) 1-18 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "contextual definitions" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 is rejected for fully incorporated the deficiencies of the base claim from which it depends.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5, and 8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of Huang (U.S. Provisional Application 60/179,330).

As per claim 1, Jamtgaard discloses a computer-implemented method for generating electronic documents including receiving data from at least one application program (See Jamtgaard, Column 8, lines 25-46, and Figure 5, element 60), dividing

the data into text data, graphics data, and context data (See Jamtgaard, Column 13, lines 24-67, and Column 14, lines 1-3), storing in cards at least a portion of the text data, graphics data, or context data, where at least a portion of the context data is stored in XML format (See Jamtgaard, Column 13, lines 45-50). Jamtgaard does not disclose expressly generating at least one file for storing at least a portion of the data. Huang discloses generating a file to store data (See Huang, Page 13, lines 21-23). Jamtgaard and Huang are analogous art because they are from the same field of endeavor of manipulating web-based data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the file of Huang with the storage of at least a portion of data of Jamtgaard. The motivation for doing so would have been to enable the export of data into a document database (See Huang, Page 13, lines 21-24). Therefore, it would have been obvious to combine Huang with Jamtgaard for the benefit of exporting the stored data into a document database to obtain the invention as specified in claim 1.

As per claim 2, Jamtgaard and Huang disclose the limitations of claim 1 as described above. Huang also discloses separating text data from font or glyph data (See Huang, Figure 5, Page 12, lines 24-26, and Page 13, lines 1-3). Jamtgaard and Huang are analogous art because they are from the same field of endeavor of manipulating web-based data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the separation of text and font data of Huang with the document generation method of Jamtgaard and Huang. The motivation for doing so would have been to provide an editing environment to alter the font

attributes such as font type, font style, font color, font size and font effects for selected data elements (See Huang, Page 12, lines 12-15). Therefore, it would have been obvious to combine Huang with Jamtgaard and Huang for the benefit of providing an editing environment to alter font attributes of selected data elements to obtain the invention as specified in claim 2.

As per claim 3, Jamtgaard and Huang disclose the limitations of claim 1 as described above. Jamtgaard also discloses generating respective files, or cards, for the text data, graphics data, and contextual definitions (See Jamtgaard, Column 17, lines 1-5, and lines 28-36).

As per claims 5 and 8, Jamtgaard and Huang disclose the limitations of claim 1 as described above. Huang also discloses permitting a user to specify at least one property of the first file, including a template type (See Huang, Page 12, lines 15-24, and Figure 5) before that first file is generated (See Huang, Page 12, lines 10-15). Jamtgaard and Huang are analogous art because they are from the same field of endeavor of manipulating web-based data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the specification by the user of a property of the first file, including a template type, before the file is generation of Huang with the method of Jamtgaard and Huang. The motivation for doing so would have been to provide an editing environment to alter the font attributes such as font type, font style, font color, font size and font effects for selected data elements (See Huang, Page 12, lines 12-15). Therefore, it would have been obvious to combine Huang with Jamtgaard and Huang for the benefit of providing an editing environment to

alter font attributes of selected data elements to obtain the invention as specified in claims 5 and 8.

As per claim 9, Jamtgaard and Huang disclose the limitations of claim 1 as described above. Jamtgaard also discloses transmitting the data to a parser, or content cutter, to determine if the data is text data or graphics data (See Jamtgaard, Column 13, lines 24-44) and transmitting the data to a formatter, or layout processor, to determine the optimal format for the data (See Jamtgaard, Column 13, lines 27-34).

As per claim 10, Jamtgaard and Huang disclose the limitations of claim 1 as described above. Huang also discloses transmitting the data to a file manager, or transformation module, after the data is divided but before the file is generated (See Huang, Page 13, lines 4-8, lines 24-26, and Page 14, line 1). Jamtgaard and Huang are analogous art because they are from the same field of endeavor of manipulating web-based data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the transmitting of the data to a file manager, or transformation module, after the data is divided but before the file is generated of Huang with the method of Jamtgaard and Huang. The motivation for doing so would have been to provide an editing environment to alter the attributes for selected data elements (See Huang, Page 12, lines 12-15). Therefore, it would have been obvious to combine Huang with Jamtgaard and Huang for the benefit of providing an editing environment to alter attributes of selected data elements to obtain the invention as specified in claim 10.

As per claim 11, Jamtgaard and Huang disclose the limitations of claim 1 as described above. Huang also discloses that the application program includes a word processing program (See Huang, Page 3, lines 4-7, and Page 5, lines 6-7). Jamtgaard and Huang are analogous art because they are from the same field of endeavor of manipulating web-based data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the word processing program of Huang with the method of Jamtgaard and Huang. The motivation for doing so would have been to provide a word processing view as well as a structural view of the data (See Huang, Page 3, lines 3-4). Therefore, it would have been obvious to combine Huang with Jamtgaard and Huang for the benefit of providing provide a word processing view as well as a structural view of the data to obtain the invention as specified in claim 11.

As per claim 12, Jamtgaard and Huang disclose the limitations of claim 1 as described above. Jamtgaard also discloses including a text portion in XML format, if the data received from the application program includes text data, and a graphics portion, if the data received from the application program includes graphics data (See Jamtgaard, Column 13, lines 24-50).

As per claim 13, Jamtgaard and Huang disclose the limitations of claim 12 as described above. Huang also discloses including a glyph and font portion in XSL format, if the data received from the application program includes text data (See Huang, Figure 10, and Page 14, lines 11-22). Jamtgaard and Huang are analogous art because they are from the same field of endeavor of manipulating web-based data. At the time of the invention it would have been obvious to a person of ordinary skill in the

art to include the inclusion of glyph and font portion in XSL format of Huang with the document generation method of Jamtgaard and Huang. The motivation for doing so would have been to provide an editing environment to alter the font attributes such as font type, font style, font color, font size and font effects for selected data elements (See Huang, Page 12, lines 12-15). Therefore, it would have been obvious to combine Huang with Jamtgaard and Huang for the benefit of providing an editing environment to alter font attributes of selected data elements to obtain the invention as specified in claim 13.

As per claim 14, Jamtgaard and Huang disclose the limitations of claim 1 as described above. Jamtgaard also discloses that the file has a first file format which is different from a file format of the application program (See Jamtgaard, Claim 1).

As per claims 15-18, Jamtgaard discloses a computer system and computer readable medium including at least one server (See Jamtgaard, Figure 4, and Column 3, lines 17-18), at least one user computer coupled to the server through a network (See Jamtgaard, Column 6, lines 21-24 and Column 7, lines 1-5), where the server includes a program stored therein (See Jamtgaard, Figure 4, element 42), where the program receives data from at least one application program (See Jamtgaard, Column 8, lines 25-46, and Figure 5, element 60), where the program divides the data into text data, graphics data, and context data (See Jamtgaard, Column 13, lines 24-67, and Coumn 14, lines 1-3), and where the program generates cards for storing a portion of the text data, graphics data, or context data, where at least a portion of the context data is stored in XML format (See Jamtgaard, Column 13, lines 45-50). Jamtgaard does not

disclose expressly generating a file for storing at least a portion of the data. Huang discloses generating a file to store data (See Huang, Page 13, lines 21-23). Jamtgaard and Huang are analogous art because they are from the same field of endeavor of manipulating web-based data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the file of Huang with the storage of at least a portion of data of Jamtgaard. The motivation for doing so would have been to enable the export of data into a document database (See Huang, Page 13, lines 21-24). Therefore, it would have been obvious to combine Huang with Jamtgaard for the benefit of exporting the stored data into a document database to obtain the invention as specified in claims 15-18.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of Huang (U.S. Provisional Application 60/179,330) as applied to claim 3 above, and further in view of Ballantyne (U.S. Patent 6,687,873 B1).

As per claim 4, Jamtgaard and Huang disclose the limitations of claim 3 as described above. Jamtgaard and Huang do not disclose expressly receiving a print stream from the application program. Ballantyne discloses receiving a print stream of data (See Ballantyne, Column 17, lines 53-62). Jamtgaard, Huang and Ballantyne are analogous art because they are from the same field of endeavor of manipulating web-based data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the print stream of Ballantyne with the method of

Jamtgaard and Huang. The motivation for doing so would be to facilitate improved data extraction (See Ballantyne, Column 17, lines 58-60). Therefore, it would have been obvious to combine Ballantyne with Jamtgaard and Huang for the benefit of facilitating improved data extraction to obtain the invention as specified in claim 4.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of Huang (U.S. Provisional Application 60/179,330) as applied to claim 5 above, and further in view of Barile (U.S. Patent 6,560,621 B2).

As per claim 6, Jamtgaard and Huang disclose the limitations of claim 5 as described above. Jamtgaard and Huang do not disclose expressly including a location for the file. Barile discloses that a property specified is a location for the file. (See Barile, Column 5, lines 1-5). Jamtgaard, Huang and Barile are analogous art because they are from the same field of endeavor of generating and formatting structured documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the specific property being the location of the file, as disclosed by Barile, with the method for generating electronic documents of Jamtgaard and Huang. The motivation for doing so would have been to provide the information necessary to a print driver to allow the document to be printed. (See Barile, Column 4, lines 65-67). Therefore, it would have been obvious to combine Barile with Jamtgaard and Huaug for the benefit of printing the document.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of Huang (U.S. Provisional Application 60/179,330) as applied to claim 5 above, and further in view of DeRose (U.S. Patent 5,557,722).

As per claim 7, Jamtgaard and Huang disclose the limitations of claim 5 as described above. Jamtgaard and Huang do not disclose expressly that a property specified is security information for a file. DeRose discloses that attributes may be modified to provide security for a document. (See DeRose, Column 8, line 67, and Column 9, lines 1-9). Jamtgaard, Huang, and DeRose are analogous art because they are from the same field of endeavor of generating and formatting structured documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the method of generating electronic documents of Jamtgaard and Huang with the modifiable attribute based on security considerations of DeRose. The motivation for doing so would have been to allow for user customization of the output data based on specific concerns, such as providing security for the document. (See DeRose, Column 9, lines 2-5). Therefore, it would have been obvious to combine DeRose with Jamtgaard and Huang for the benefit of providing document security to obtain the invention as specified in claim 7.

Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jamtgaard (U.S. Patent 6,430,624 B1) in view of Ballantyne (U.S. Patent 6,687,873 B1).

As per claim 19, Jamtgaard discloses a computer system including an operating system operating on at least one computer (See Jamtgaard, Column 4, lines 39-44), and an application program operating on the computer (See Jamtgaard, Column 4,lines 39-44). Jamtgaard does not disclose expressly an additional program for handling print requests from the application program using the operating system and manipulating at least one data stream to create a format independent document. Ballantyne discloses functionality to handle print requests in the form of a print stream of data (See Ballantyne, Column 1, lines 56-67, and Column 2, lines 1-3). Jamtgaard and Ballantyne are analogous art because they are from the same field of endeavor of manipulating web-based data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the functionality to handle print requests of Ballantyne with the method of Jamtgaard. The motivation for doing so would have been to make conventional legacy reports or data available in different formats (See Ballantyne, Column 1, lines 56-58). Therefore, it would have been obvious to combine Ballantyne with Jamtgaard and Huang for the benefit of making conventional legacy reports or data available in different formats to obtain the invention as specified in claim 19.

As per claim 20, Jamtgaard and Ballantyne disclose the limitations of claim 19 as described above. Jamtgaard also discloses a parser, or content cutter, component for separating text data from graphics data (See Jamtgaard, Column 13, lines 24-67, and Column 14, lines 1-3), a formatter component for formatting the text data or graphics data (See Jamtgaard, Column 13, lines 19-22, and Figure 10, element 62), and a file

manager component for ensuring that the format independent document is created in a specified location (See Jamtgaard, Column 10, lines 48-56).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Brooke (U.S. Patent 6,763,343 B1) discloses preventing duplication of the data in reference resource for XML page generation.
- Brooke (U.S. Patent 6,748,569 B1) discloses XML server pages language.
- Anthony (U.S. Publication 2003/0069908 A1) discloses software composition using graph types, graph, and agents.
- Chau (U.S. Publication 2002/0123993 A1) discloses XML document processing.
- Story (U.S. Publication 2002/0129058 A1) discloses hypermedia document publishing including hypermedia document parsing.
- Friedman (U.S. Patent 6,675,353 B1) discloses methods and systems for generating XML documents.
- Dinkelacher (U.S. Patent 6,092,068) discloses a marked document tutor.
- Wallace discloses generic combinators and type-based translation.
- Suzuki discloses managing the software design documents with XML.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. The examiner can normally be reached on Monday-Friday from 7:00am to 3:30pm.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached at (571) 272-4090.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER